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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,549	02/08/2006	Mitsutoshi Shinkai	SON-3073	2507
23353 7590 05/27/2009 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				
EXAMINER				
ZHAO, DAQUAN				
ART UNIT		PAPER NUMBER		
2621				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/567,549

Applicant(s)

SHINKAI ET AL.

Examiner

DAQUAN ZHAO

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2007 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISAC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: 3/5/2009; 2/6/2006; 12/4/2006

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 is rejected under 35 U.S.C. 101 based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory. The claimed invention can be an abstract written on a piece of paper as flow chart(s) as shown in figures 32-33 of the instant application

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

Claim 10 is rejected under 35 U.S.C. 101 because claimed is directed to a program per se, which is non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al (US 6,134,378).

For claim 1, Abe et al teaches A playback apparatus for playing back video data, comprising: identifying means for identifying second position information which is relative position information, relative to a starting frame of the video data, of a playback frame which is a frame corresponding to a frame playback instruction using first position information which is absolute position information as to each frame of the video data (e.g. column 12, line 20- column 13, line 25, figure 4, VITC is added to the head of the data stream (SOM), Therefore the head frame must be identified by the VITC since one time code can only identified one video frame in the video art, column 7, lines 49-60 teach the VITC shows real time. The examiner considers the head frame identified by

the VITC corresponds to the claimed "absolute position", the "FTC" shows the relative position from the head frame, and the examiner considers the frame identified by the "FTC" to corresponds to the claimed "second position"); and playback means for playing back the playback frame corresponding to the second position information identified by the identifying means (e.g. column 15, lines 1-32, figure 9, the VITC and the FTC are used during the reproduction procedure when the video is editing by user).

Claims 9-10 are rejected for the same reasons as discussed in claim 1 above.

For claim 2, Abe et al teach the first position information is a time code indicating an absolute position of the frame, using a real time (e.g. column 7, lines 49-60 teach the VITC shows real time. The examiner considers the head frame identified by the VITC corresponds to the claimed "absolute position").

For claim 3, Abe et al teach the first position information is a time code indicating an absolute position of the frame, using time information relative to a predetermined time (e.g. column 7, lines 49-60 teach the VITC shows real time. The examiner considers the head frame identified by the VITC corresponds to the claimed "absolute position" and the "real time" corresponds to the claimed "predetermined time").

For claim 4, Abe et al teach the second position information is a time code indicating a relative position of the frame, using a frame number indicating the number of frames counted from the starting frame of the video data (e.g. column 15, lines 16-32, the "stamped picture", which is scaled down display of the frame video, of plural number of frames corresponds to the "indicating the number of frames counted from the starting frame of the video data").

For claim 5, Abe et al teach the identifying means identifies the second position information as to the playback frame, based on table information that associates the first position information with the second position information and has an element of a correlation between the first position information and the second position information at a change point which is a frame where a type of change pattern of a value of the first position information changes (e.g. column 15, lines 16-32, scaled down display of the time code must shows change in the time code as the display of frames progress, column 12, lines 48-61 teach a table includes VITC time codes).

For claim 6, Abe et al teach each element of the table information includes status information indicating a type of change pattern of a value of the first position information as to a frame after the change point (e.g. column 15, lines 16-32, "date of photo shooting, the model name, serial number, cassette number and location of photo shooting" corresponds to the claimed "indicating a type of change pattern of a value").

For claim 7, Abe et al teach status section which is grouped by the change point in the table information and composed of a plurality of consecutive frames having the same status information, the identifying means performs determination whether the first position information of the playback instruction exists, and identifies the second position information as to the playback frame, based on a result of the determination (e.g. figure 9, column 15, lines 1-52, user can instruct displaying the video according to "date of photo shooting, the model name, serial number, cassette number and location of photo shooting").

For claim 8, Abe et al teach the identifying means performs the determination in turn for consecutive status sections in a direction that increases the second position information if a value of the first position information of the playback instruction is larger than a value of the first position information as to a frame that is currently played back, and the identifying means performs the determination in turn for consecutive status sections in a direction that decreases the second position information if a value of the first position information of the playback instruction is smaller than a value of the first position information as to a frame that is currently played back (e.g. figure 9, the slider bar, which is element 801, and element of 80c in figure 9, gives the user options to fast forward and rewind from the current position of the video stream by looking at the time code 80C to go to the section of video he/she wants to see during the editing process).

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hirabayashi et al (US 6,002,834).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daquan Zhao whose telephone number is (571) 270-1119. The examiner can normally be reached on M-Fri. 7:30 -5, alt Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Thai Q, can be reached on (571)272-7382. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daquan Zhao/
Examiner, Art Unit 2621

/JAMIE JO VENT ATALA/
Examiner, Art Unit 2621